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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/381,794 12/27/99 HUNTER J 454313-2540

HM22/1012

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EXAMINER

LEVY, N

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

10/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

381294

Applicant(s)

HUNTER et al

Examiner

NEC Guy

Group Art Unit

1616

8

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/17/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15, 17-21 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15, 17-21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-15, 17-21 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 67
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Receipt is acknowledged I IDS, supplement art and amendment. The Title is for ticks-
please charge.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 9-15, 17-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Only limited forms of formula (I) have been shown to be effective for the claimed control; which again, is only presented is limited form for limited conditions, for the claimed specific; but not for all compounds or compound groups.

The proviso for exclusion is questioned-the basis for this proviso (claim 1) should be explained.

Claims 1-15, 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following are indefinite terms: "such as", "preferably", and,"especially", and "characterized", "derivatives" "concentrated", "Long".

It is unclear what "effecticiously" is effective for. There is a period at line 10 of claim 6. Claim 19 is ambiguous optionally speaking, as is 20; there is no "prepared" antecedent in 8.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-14, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeannin 6096329.

See the claims.

Claims 1-12, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Frontline or Meo et al-'96.

See brochure of Frontline, abstract of MEO.

Claims 1, 9-15, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4443888-Sirinyan.

See Benpiel, 1, 8,9-Imidacloprid, Solvent, Cosolvent and Crystallization inhibitions are used for eraduation of Fleas, ticks by premises application, at the instant concentration, with juvenile hormones chitin synthesis inhibitors (p.71 and avermeitn (p.8).

Claims 1-12, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizutani et al -WO 9616544.

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As above the instant claim 12 format (p.4) applied to pet premises (P.5) or pets at the instant concentration incorporate the instant compound (A-p.2)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frontline or Mizutani et al in view of

Chatfield et al EP 0516590, MEO et al and Sirinyan et al.

Frontline and Mizutani (above) provide the essence of the instant invention, but not all combinations. Chatfield show efficacy of various formulations for pet application. Of combination actives (p.2,3) MEO show advantageous use of Frontline over the Chatfield ovitrol, thus, obvious to use for increased efficaciousness, while Sirinyan show additional combinations of either AVENECTIN or juvenile hormone antagonists with Imidacloprid are efficaciously provided.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize a combination composition, to use one of Frontline or Mizutani to control fleas, with modification to enhance efficacy, duration of effect, and minimize re-contamination. Chatfield teach one having ordinary skill in the art would be motivated to perform this modification to provide efficacy against particular pests of interest. Teaching Ivermectins

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further elucidate use of optimization to provide both ectoparasiticial endoparasiticial control with topical administration by spot on.

The selection of each ingredient is a result effective parameter chosen to obtain the desired effects. It would be obvious to vary the nature of each ingredient to optimize the effect desired.

There is no unusual an/or unexpected results obtained since the prior art is well aware of the use of the instant actives and of the specific carriers, vehicles, surfactants, solvents and adjuvant common to the art of pesticidal composition, and the use of ingredients for the functionality for which they are know to be used is not a basis for patentability.

It has not clearly been established by an objective showing of some additional unusual and/or unexpected result that the administration of the particular active or adjuvant ingredient forms ratios provided any greater level of prior art expectation as claimed.

No claim is allowed.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 18-20, drawn to methods, classified in class 424, subclass 405.
- II. Claims 17,21, drawn to Kits, classified in class 206, subclass 528.

The inventions are distinct, each from the other because:

The methods can be used irrespective and independent of the Kit, which can be used in other methods.

This application contains claims directed to the following patentably distinct species of the claimed invention: Compound Species, Formula I or II.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Compound of Formula I, choose R_1 , CN, Methyl or Halogen.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 4-6, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_2 form

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 4-7, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I R_3 form.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 6, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_4 form.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6, 9-15, 17-21 are generic.

early admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_5 , 6 forms

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_7 form.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_8 form.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_{10} form.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_{11} forms.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-6, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, R_{12} forms.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-6, 9-15 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I-Hals or Haloalky, haloalkoxy or **S** form.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3, 5, 6, 9-15, 17-21 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: Formula I, $X=N$ or R_{12} .

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,4-7, 9-15, 17-21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group is not required for Group , restriction for examination purposes as indicated is proper.

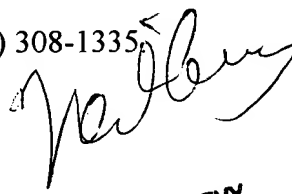
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday thru Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1335.

Levy/sg

10/5/00


NEIL S. LEVY
PRIMARY EXAMINER